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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/506,819

04/19/2005

Masayuki Kawakami

LEDER-0010

5431

23599 7590 10/18/2007
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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

10/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/506,819

Applicant(s)

KAWAKAMI ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 8 and 11-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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ACKNOWLEDGMENT

1. The Examiner acknowledges receipt of the amendment filed 7/26/07 wherein claims 1, 4, and 9-11 were amended; claims 3, 6, and 7 were canceled; and claims 12 and 13 were added.

Note: claims 1, 2, 4, 5, and 8-13 are pending.

RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS

2. The Applicant's arguments and/or amendment filed 7/26/07 to the rejection of the claims made by the Examiner under 35 USC 103, 112, and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

Double Patenting Rejections

The rejection of claims 1, 2, 4, and 5 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-8 of US Patent No.

6,939,975 is MAINTAINED for reasons of record in the office action mailed 2/26/07 and those set forth below.

Applicant asserts that the double patenting rejection must be withdrawn because the patented claims are directed to compounds and the claims of the instant invention are drawn to diagnostic contrast agents suitable for near infrared fluorescent imaging and corresponding methods thereof.

Applicant's arguments are non-persuasive because both sets of claims are directed to compounds having the same components. Furthermore, if the product components are the same and a product is inseparable from its properties, then if the claims of the instant invention are useful as a diagnostic agent, then so are the patented

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products. In addition, it is noted that while Applicant asserts that the instant invention is useful as a diagnostic agent, the claims do not require the presents of a detectable isotope. Thus, the claims contain overlapping subject matter and the double patenting rejection is deemed proper.

112 Second Paragraph Rejections

I. The rejection of claims 1-11 as being ambiguous because of the wording of claim 1 is WITHDRAWN because Applicant has amended the claims to overcome the rejection

II. The rejection of claim 1 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is MAINTAINED.

In particular, the rejection of claim 1, lines 9-10, as being confusing because it states that R3, R4, R5, R6, R9, R10, R11, and R12 bind to each other to form a ring is MAINTAINED for reasons of record in the office action mailed 2/26/07 and those set forth below. Once again, the variable all do not bind to one another to form a ring. It is groups of twos (i.e., R3 and R4) that bind to form a ring. Thus, Applicant is once again respectfully requested to clarify the claims in order that one may readily ascertain what is being claimed.

Note: It is duly noted that Applicant did not respond to the Examiner's rejection in the response.

III. The rejection of claim 1, line 18, is WITHDRAWN because Applicant has amended the claim to overcome the rejection.

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IV. The rejection of claims 9 and 10 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is MAINTAINED.

In particular, it was previously stated that the claims are not further limiting. The Examiner asked if Applicant intended to write 'A method of tumor imaging...'. The claims do not further limiting the contrast agent of claim 1 because a product claim is limited by further defining its component, not by incorporating the intended use of the contrast agent.

Note: While Applicant amended claims 9 and 10 to state that the contrast agents are adapted for a particular use, it is noted that the amending of the claims does not further limit the components of the product.

103 Rejections

The 103 rejections are WITHDRAWN because Applicant has amended the claims to overcome the rejections.

COMMENTS/NOTES

3. Applicant is respectfully requested to replace 'A' with 'The' in claims 12 and 13.
4. It is duly noted that no prior art is cited against the instant claims. However, Applicant MUST address and overcome the double patenting rejection above. The claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious the contrast agents of the instant invention or uses

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thereof. The closest art is Applicant's own work that is cited in the double patenting rejection above.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'D. L. Jones', is positioned above the printed name.

D. L. Jones
Primary Examiner
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October 10, 2007